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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,632	09/15/2003	David Fu	10448	9754

36396 7590 04/04/2007  
DAVID WEISS  
12650 RIVERSIDE DRIVE  
SUITE 100  
NORTH HOLLYWOOD, CA 91607-3442

EXAMINER
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HOGE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/662,632

Applicant(s)

FU, DAVID

Examiner

Gary C. Hoge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-24, 26-59, 61-67, 69, 70, 73, 74 and 76-85 is/are pending in the application.
- 4a) Of the above claim(s) 7-11, 20-24, 26-37, 47, 48, 62 and 80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-19, 38-46, 49-59, 61, 63-67, 69, 70, 73, 74, 76-79 and 81-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 7-11, 20-24, 26-37, 47, 48, 62 and 80 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 3, 2005.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 13-18, 38-45, 49-58, 61, 63-67, 69, 70, 73, 74, 76-79 and 81-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neugebauer (5,522,163) in view of Wang (5,502,907).

Neugebauer discloses in Figs. 1-3 a protective display holder comprising a substantially rigid base **24** having a first edge and an opposite second edge, the base including a flat top surface **26** and a recess **48**, a substantially rigid cover **14** having a first edge and an opposite second edge, the cover including a flat bottom surface **18**, retaining means **20**, **32** adjacent to the first edge of the base and to the first edge of the cover for releasably retaining the bottom surface to the top surface, and a fastener **38** adjacent the second edges of the base and cover for securing the bases and cover together. However, Neugebauer uses a screw, rather than first and second magnetic members, to secure the cover to the base. Wang teaches that it was known in the art to

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use first **13** and second **23** magnetic members to secure a transparent cover to a base. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the screw disclosed by Neugebauer with magnets, as taught by Wang, in order to obviate the need for a screwdriver. Neugebauer shows in Figs. 1 and 3 that the cover includes a recess **46** that receives a protrusion/collar **36** formed on the base. The magnetic members taught by Wang would be embedded within the recess in the cover and in the protrusion/collar formed on the base.

Regarding claims 2, 40, 51 and 67, the cover and base are formed from transparent material.

Regarding claims 3, 39, 50 and 63, the recess has depth and peripheral dimensions equal to or greater than a respective thickness and peripheral dimension of the flat item. See column 3, lines 37-39.

Regarding claim 6, Neugebauer shows in Figs. 1 and 3 that the base includes at least one aperture **32** and at least one projection **20** on the cover.

Regarding claims 13, 61 and 83, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the protrusion/collar on the cover and the recess within the base of Neugebauer because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 166 (CCPA 1931).

Regarding claims 16, 18, 43, 45, 56, 58, 69, 70, 73, 74, 76 and 77, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the configuration of the collar and indentation in the shape of an oval (Neugebauer teaches the idea

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of making the collar and indentation in the shape of a circle) because it has been held that changes in the shape of an article are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed article is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

4. Claims 19, 46 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neugebauer (5,522,163) in view of Wang (5,502,907) as applied to claims 1, 38 and 49 above, and further in view of Cameron (5,186,566).

Neugebauer, as modified, discloses the invention substantially as claimed, as set forth above. However, Neugebauer, as modified, does not disclose a finger notch along at least one of the second edges. Cameron teaches in Figs. 1-4, first and second panels that include finger notches **42** along the edges of each of the panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Neugebauer by placing a finger notch along at least one of the second edges, as taught by Cameron, because this would allow the cover and base to be separated in an easier manner.

#### ***Response to Amendment***

5. The declarations under 37 CFR 1.132 filed June 26, 2006 and December 11, 2006 are insufficient to overcome the rejection of the claims based upon Neugebauer and Wang as set forth in the last Office action because the declarations refer only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. Further, evidence showing commercial success of trading-card holders is not commensurate in scope with claims directed to “a protective display

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holder for a flat item” broadly. Still further, although Applicant is of the opinion (as stated in the most recent declaration) that purchasers purchased the instant invention because of its magnetic latch, that opinion is insufficient to demonstrate a nexus between the sales and the claimed invention. See MPEP § 716.03(b). Also, it is noted that merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). See MPEP § 716.03(b). In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

#### ***Response to Arguments***

6. Applicant's arguments filed December 11, 2006 have been fully considered but they are not persuasive.

Regarding Neugebauer, disclosing a certain closure means (e.g., a threaded fastener) is not the same as teaching away from every other type of fastener. Unless Neugebauer discusses the undesirability of using a magnetic closure, it does not teach away from it.

#### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch